



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 09/900,627 | 07/06/2001 | Charles David Weaver | 3035-4086US1 | 7563 |
| 23914 | 7590 | 10/11/2007 | | |
| LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000 | | | EXAMINER CHEU, CHANGHWA J | |
| | | | ART UNIT 1641 | PAPER NUMBER |
| | | | NOTIFICATION DATE 10/11/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@BMS.COM
patents@bms.com
eileen.immordino@bms.com

Office Action Summary

Application No.

09/900,627

Applicant(s)

WEAVER ET AL.

Examiner

Jacob Cheu

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1641

Status of Claims

Applicant's amendment filed on 7/23/2007 has been received and entered into record and considered.

The following information provided in the amendment affects the instant application:

1. Claims 32-120 are cancelled.
2. Currently, claims 1-32 and 121 are under examination.

Claim Rejections - 35 USC § 112

New Matter

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-32 and 121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that claim 1, line 8, the feature of "the pores being spaced apart such that only one pore may contact an individual cells", does not have support from the specification.

In light of specification, only the original claim 78 touches this feature, albeit not in full support.

78. An apparatus for measuring cellular electrical conditions comprising a Microchip component adapted to hold cells which comprises non-conductive material including a top surface and

Art Unit: 1641

bottom surface, wherein the top surface of the material includes cell attachment sites that are sized to contact individual cells and are coupled to an electrode lead/signal modifying circuitry.

Here the “cell attachment sites that are sized to contact individual cells” feature does not support the recited feature “the pores being spaced apart such that only one pore may contact an individual cell” (emphasis added).

Applicant is invited to point out the support of the recited feature from the specification.

Response to Applicant's Arguments

3. Claims 1-4, 12-13, 20-26 rejected under 35 U.S.C. 102(e) as being anticipated by Rava et al. are withdrawn because Rava et al. do not teach the recited feature “wherein the pores of the materials are capable of forming electrically *tight seals* with the contact cells at the cell attachment sites” (emphasis added).

Examiner disagrees with applicant's arguments that the illustration of Figure 5 is not a through hole as recited in the current claim 1. Applicant argues that no pores described in Figure 5 “that extends through any of the substrate layer”. Examiner would invite applicant's attention that the instant recitation does not recite a through hole that “extends any of the substrate” (See claim 1 (i)). Furthermore, according to Figure 5 of the Rava et al. reference, the overall array of wells in Figure 5 can be considered as one layer, thus each well is a through hole contacting the bottom substrate. Nevertheless, it is the feature of “wherein the pores of the materials are capable of forming electrically *tight seals* with the contact cells at the cell attachment sites” distinguishes from this reference because the wells of Rava et al. are too large to form electrically tight seals with contacted cells.

4. Similarly, claims 1-2, 12-13, 15, 18-19, 20-26, 28-29 rejected under 35 U.S.C. 102(e) as being anticipated by McDevitt et al. are withdrawn because McDevitt et al. do not teach the recited feature “wherein the pores of the materials are capable of forming electrically *tight seals* with the contact cells at the cell attachment sites” (emphasis added).

Art Unit: 1641

Examiner disagrees with applicant's arguments that the "cavities" in Figure 2 is not "pores". With respect to what applicant's recitation, the instant claimed pores would extend through the top and bottom surface of the first layer. In view of the Figure 2 of McDevitt et al., examiner considers the component 210 is the first layer, and the cavity formed therein can be considered as a "through hole" from the top of the surface to the bottom of the surface of this layer. It is the feature of "wherein the pores of the materials are capable of forming electrically *tight seals* with the contact cells at the cell attachment sites" distinguishes from this reference because the cavities are too large to form electrically tight seals with the contacted cells.

Withdrawn Allowable Subject Matter

5. The allowable claims 6-7, 27 and 121 are withdrawn due to lack of support for the claim 1 (new matter).

6. No claim is allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 571-272-0814. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jacob Cheu
Examiner
Art Unit 1641



September 28, 2007


LONG V. LE 09/30/07
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600